



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masashi UEDA et al.

Application No.: 09/830,879

Filed: May 2, 2001

Group Art Unit: 1763

Examiner: P. Hassanzadeh

Docket No.: 109426

For: INTERNAL ELECTRODE TYPE PLASMA PROCESSING APPARATUS AND  
PLASMA PROCESSING METHOD

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In reply to the November 13, 2002 Office Action with Restriction and Election of Species Requirements, Applicants provisionally elect Group I, claims 1-14, and Species III, Figures 4 and 5, claims 1-7, 10-12 and 14, with traverse. Applicants submit that at least claims 1, 5 and 11 are generic to all species. Reconsideration based on the following remarks is respectfully requested.

The Office Action restricts between Group I, comprising claims 1-14, drawn to a plasma processing apparatus, and Group II, comprising claims 15-18, drawn to a plasma processing method.

The Office Action further asserts that if Group I is selected, an election must be made between Species I, drawn to Figs. 1 and 2; Species II, drawn to Fig. 3; Species III, drawn to Figs. 4 and 5; and Species IV, drawn to Fig 7.

Applicants hereby provisionally elect Group I, Species III, drawn to Figs. 4 and 5, with traverse, under 37 CFR §1.143. In addition to claims 4, 7 and 10 as indicated in the

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Office Action, Applicants assert that because claims 1, 5 and 11 are generic to all four species, and therefore belong in Group I, Species III, by virtue of the feature "an electrode" being commonly interpreted as "one or many" of such devices. Applicants further assert that claims 2, 3, 6, 12 and 14 also belong in Group I, Species III. Therefore, Applicants assert that claims 1-7, 10-12 and 14 together belong in Group I, Species III.

Under MPEP §806.05(e), inventions for a process and a corresponding apparatus for its practice are independent and distinct only if (1) the process as claimed can be practiced by another materially different apparatus or by hand, and/or (2) the apparatus as claimed can be used to practice another and materially different process.

The Office Action alleges that the two Groups have special technical features related to a plasma processing apparatus and a plasma processing method, respectively. For at least the following reasons, this ground is insufficient to establish a *prima facie* case for regarding restriction under MPEP §806.05(f) and the Administrative Procedure Act (APA) requirements for procedural and substantive due process. See *Dickinson v. Zurko*, 527 U.S. 150, 119 S.Ct. 1816 (1999).

Applicants assert that the process and apparatus are not distinct within the meaning of MPEP §802.01. Claims 15-18, from Group II, are directed to a plasma processing method, and recite, as features, each of the method steps for plasma processing to produce a standing wave of one wavelength of elected Group I, Species III. The asserted apparatus is literally within the scope of method claims 15-18 as pending. Therefore, the asserted apparatus is not a "materially different" apparatus from that claimed in the method claims from Group II, and the claims satisfy unity of invention under 35 U.S.C. §121.

Further, claims 1-14, from Group I, are directed to a plasma processing apparatus, and recite an electrode to produce a standing wave when supplied with high frequency power. Such apparatuses are applicable to a plurality of electrodes without distinction of the claimed

features to the practicing apparatus. Applicants assert that Species I, II and IV in Group I cannot be distinguished from Species III for Restriction purposes. Therefore, Group I applies to a generic invention, without proper subdivision into Species I-IV.

Even if the related claims in Groups I and II, or related claims in Species I, II, III and IV of Group I, are determined to be distinct, under MPEP §808.02 the Examiner must show either (1) separate classification, (2) separate status in the art, or (3) a different field of search. While the Examiner has identified Groups I and II under separate classes, the subject matter overlap of all claims 1-22 within the art enables a search for one group to be co-extensive with the remaining group. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden.

MPEP §803 states that "if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Because the asserted process, on which the Restriction Requirement is based, is not a materially different process from that performed by the claimed apparatus, and because the Office Action has not identified a materially different apparatus to perform the claimed process, the Office Action has failed to meet the requirements either of MPEP §806.05(e) or the APA. Thus, the Office Action has failed to establish a *prima facie* case that restriction is proper.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,



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